

Remarks

Upon entry of the foregoing amendments, claims 36, 37, 40, 41, 43, 44 and 46-49 are pending in the application, with claim 36 being the independent claim. Claims 1-35 and 39 were previously canceled. Claims 38, 42, 45, and 50-57 are canceled herein without disclaimer or prejudice as these claims were withdrawn as a result of a restriction requirement.

Claims 36, 41, and 43 have been amended to correct minor nonsubstantive errors, and Claim 36 has also been amended to make explicit that which is implicit.

Claims 46 and 47 have been amended to address the Examiner's concerns. Support can be found throughout the specification, for example, at page 19, line 20, and page 20, line 19. These amendments were not presented earlier because Applicants believed that all of the rejections were sufficiently traversed in the Amendment and Reply Under 37 C.F.R. § 1.111, filed January 21, 2003. However, solely to expedite prosecution for allowance or to put the application in better form for appeal, claims 46 and 47 have been amended.

These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Acknowledgment for Claim of Domestic Priority Under 35 U.S.C. § 119(e)

On February 28, 2002, Applicants filed a "Reply to Restriction Requirement and Second Preliminary Amendment" (Amendment). In the Amendment, Applicants claimed priority to the U.S. Provisional Application No. 60/126,767, (the '767 application) filed

March 3, 1999. (Applicants also claimed priority to the '767 application in the "Preliminary Amendment" filed August 3, 2000). However, in the Office Action dated April 8, 2002, Box 14 was not checked. Thus, Applicants respectfully request a communication from the Examiner acknowledging the domestic priority claim.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 46 and 47 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse.

As previously asserted by Applicants in the Amendment and Reply Under 37 C.F.R. § 1.111, filed January 21, 2003, the specification, at page 24, line 11, provides an 18-amino acid peptide derived from human SCC1. The specification, at page 18, line 10, discloses the *S. pombe* homologue of Scc1. The specification, at pages 19-20, provides guidelines for generating fragments and variants of SCC1 that can be cleaved by separin or having a separin cleavage site. In vitro assay for separin activity using SCC1 and sequencing of Scc1p cleavage site are provided at page 29, line 29, *et seq.*, and page 34, *et seq.* Given the skill in the art in regards to generating fragments and variants at the priority date of the captioned application (February 15, 1999), coupled with the teaching of the captioned application for assaying for SCC1 activity, it is clear that the inventors had possession of the claimed invention at the priority date.

Moreover, claim 46 has been amended to recite "wherein said substrate is human SCC1, or a fragment or variant thereof that can be cleaved by separin or having a separin cleavage site." Claim 47 has been amended to recite "wherein said substrate is a polypeptide with the amino acid sequence of SEQ ID NO:1, or a fragment or variant thereof that can be cleaved by separin or having a separin cleavage site." Thus, claims 46 and 47 are not directed to any fragments or variants; the claims are directed to human SCC1, or a fragment or variant thereof fragment or variant thereof that can be cleaved by separin or having a separin cleavage site. Applicants respectfully request that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 36, 37, 40, 41, 43, 44, and 46-49 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential steps. According to the Examiner, "[t]he claims do not recite steps that show how the inhibiting effect of the test compound inhibits sister chromatid separation in eukaryotic cells." Claim 36 has been amended to recite "thereby identifying a compound that has the activity of inhibiting sister chromatid separation in eukaryotic cells." Applicants respectfully request that this rejection be withdrawn.

Claims 46 and 47 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicants respectfully traverse.

Claim 46 has been amended to recite "wherein said substrate is human SCC1, or a fragment or variant thereof that can be cleaved by separin or having a separin cleavage site." Claim 47 has been amended to recite "wherein said substrate is a polypeptide with the amino acid sequence of SEQ ID NO:1, or a fragment or variant thereof that can be cleaved by

separin or having a separin cleavage site." Thus, claims 46 and 47 are not indefinite.

Applicants respectfully request that this rejection be withdrawn.

Separin Terminology

Applicants wish to point out that as shown in Exhibit A attached herewith, the claim term "separin" is synonymous with the term "separase." Index of Peptidase Names, page 5, <http://merops.sanger.ac.uk/indexes/index-s.htm> (last visited 10/6/2003).


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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